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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,502	01/27/1999	YOSHIKAZU KOBAYASHI	Q52863	6211

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WASHINGTON, DC 20037

EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2644

18

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/238,502

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Walter F Briney III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the appeal brief (paper 17, filed 10 June 2004), prosecution is hereby reopened and this action is non-final.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 17 recites the limitation "*the given number*" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. For the purpose of this action, the limitation is assumed to be "*the given character string*."

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 2. Claims 1-3, 5-13, and 15-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Bayless (US Patent 5,754,636).**

Claim 1 is limited to a *telephone call dialing method*. Bayless discloses a computer telephony system, the telephony functions are accessible from client

computer terminals (abstract). The GUI for making and answering calls is clearly depicted in figure 34 as well as numerous other figures. Perusing the figures also makes clear that the operating system responsible for executing the system of Bayless is capable of displaying various GUI displays, e.g. figures 30, 31, 32 (i.e. *an operating system which can display a plurality of windows*). As a portion of the features disclosed by Bayless, the ability to import phonebook entries from preexisting applications enables fast retraining of the program to support the user's preferences (column 23, line 56 to column 24, line 50; figures 31).

The steps taken for importation of phonebook entries comprise: selecting an input file (illustrated in figure 31 as RUSH.TXT), displaying values from the file (illustrated in the Map From File Value window, 362), dragging-and-dropping of the values into a corresponding desired position (illustrated as the import fields in the Map to Database window, 360), and finally saving and applying the mappings. When the file is opened the only value field that is populated is in window 362. The values in window 360 are populated after the drag-and-drop operation (column 24, lines 15-22). Because the values are strings of characters, the drag-and-drop is a selection of *a string of character information*. The claim does not actually specify that the string be stored in response to selection (i.e. dragging), only that it be stored at some point. More specifically, because the string is a part of the input file (RUSH.TXT), it is inherently *stored*. Furthermore, as seen in position 10 of window 360, a telephone number is dropped into window 362 and later imported into the database (i.e. the importing steps comprise *extracting a telephone number from the stored string of character information*).

Finally, after importing the number from the text input, Bayless discloses using the imported contact's phone number to perform a dialing operation upon lookup from the database (figure 86) (i.e. *call dialing based upon the extracted telephone number, to a line*). Therefore, Bayless anticipates all limitations of the claim.

Claim 22 is essentially the same as claim 1, and is rejected for the same reasons.

Claim 2 is limited to *the telephone call dialing method according to claim 1*, as covered by Bayless. As shown in the rejection of claim 1 and with reference to figure 31, Bayless displays values from an input text file in a File Value window (362), the values from the window are dragged-and-dropped into the database window (360). The mere fact that the string values in window 362 are displayed on a screen suggest that *the selected piece of character information is stored in a common working memory which is shared by the operating system*, because the display memory is shared by the operating system. In addition, because the string is in the input file, and the input file is accessible by the telephony application, it stands to reason that the string *is stored in a common working memory*. Therefore, Bayless anticipates all limitations of the claim.

Claim 3 is limited to *the telephone call dialing method according to claim 1*, as covered by Bayless. This claim now relates the storing of string information as a consequence of a selecting action. The selected string is selected from an input file named RUSH.TXT, at least in the example depicted in figure 31. The file is stored in a directory (i.e. *a regional designation*). Displaying the selected text in the windows of

figure 31 inherently requires the use of display memory, which is , *shared by the operating system*. Therefore, Bayless anticipates all limitations of the claim.

Claim 5 is limited to a *telephone call dialing method*. As shown in the rejection of claim 1, Bayless discloses a computer telephony system, the telephony functions are accessible from client computer terminals (abstract). The GUI for making and answering calls is clearly depicted in figure 34 as well as numerous other figures. Perusing the figures also makes clear that the operating system responsible for executing the system of Bayless is capable of displaying various GUI displays, e.g. figures 30, 31, 32 (i.e. *an operating system which can display a plurality of windows*). As a portion of the features disclosed by Bayless, the ability to import phonebook entries from preexisting applications enables fast retraining of the program to support the user's preferences (column 23, line 56 to column 24, line 50; figures 31). Also as shown in the rejection of claim 1, Bayless discloses selecting text strings from an importation window (i.e. *selecting a string of character information in a second window*) to create a mapping by dragging-and-dropping into a database window (figure 13, element 360), where the selected text strings are already stored in the input file (i.e. *storing the selected string*), using the mapping to import a telephone number into a database (i.e. *extracting a number from the stored string*) and dialing that telephone number upon performing a lookup (i.e. *call dialing based upon the extracted number, to a line*).

The method of claim 5 also includes the steps of *displaying a first window* and *displaying the extracted telephone number in the first window*. The dialing procedure

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based upon number lookup is depicted in figures 82, 83, and 86. A name is input, the name corresponding to a telephone number (figure 82). The number is returned and dialed (figure 83). Displaying the window seen in figure 82 corresponds to displaying a *first window*, and figure 83 corresponds to *displaying the extracted number* from the database *in the first window*. Therefore, Bayless anticipates all limitations of the claim.

Claim 23 is essentially the same as claim 5, and is rejected for the same reasons.

Claim 6 is limited to *the telephone call dialing method of claim 5*, as covered by Bayless. Bayless discloses that each client computer is running the Microsoft Windows operating system (column 7, lines 44-8), and as seen in figures 82 and 83, the first window is unobstructed by other windows (i.e. *wherein the first window is displayed overlapped on top of the plurality of windows displayed on the screen*). Therefore, Bayless anticipates all limitations of the claim.

Claim 7 is limited to *the telephone call dialing method of claim 5*, as covered by Bayless. As seen in figures 82 and 83, the number that is displayed is in a toolbar including the Dial button (i.e. *wherein the first window is displayed as a tool bar*). Therefore, Bayless anticipates all limitations of the claim.

Claim 8 is limited to *the telephone call dialing method of claim 5*, as covered by Bayless. As seen in figures 82 and 83, available telephone number shortcut keys (5109, 5209, 5309, etc...) are available for sped dialing. Simply clicking on any one of these allows automatic dialing, wherein automatic comprises detecting the button pressed and dialing the associated number (i.e. *selecting one of the call-dialing-keys in*

the telephone region, detecting the selected telephone number, and call-dialing based upon the detected telephone number). Therefore, Bayless anticipates all limitations of the claim.

Claim 9 is limited to *the telephone call dialing method of claim 5*, as covered by Bayless. As seen in figure 83, after a call is placed, it is displayed in an active call log (388) (i.e. *wherein the first window further comprises a call log region where the past telephone call dialing destinations are displayed*). Because the chronology of the method is not explicitly claimed, the broadest interpretation suggests that the call displayed in the log region had to have been *selected, detected, and dialed* as in the rejection of claim 8, the number in the call log would have then been displayed. Therefore, Bayless anticipates all limitations of the claim.

Claim 11 is limited to *an information terminal*, the information terminal is comprised of components that inherently perform the method steps of claim 5. The OS inherently contains the ability to display windows, including a *first window* (figures 82, 83), *the first window* allows calls to be placed using the Dial button. Also, a mouse (figure 2, element 64), included with each client station, allows *selection*. Disk drives (70) and RAM (60) allow for *storage*. The telephone application itself, with the support of the processor (58), directs a directory import wizard (column 23, line 56 to column 24, line 50; figure 31) to perform the steps of *extraction*. The application *outputs*, as a parameter to a telephony interface (element 44; column 10, lines 6-21) (i.e. TAPI), the number to be dialed. Therefore, Bayless anticipates all limitations of the claim.

Claim 10 only contains limitations already discussed in claim 11, and thus, is rejected for the same reasons.

Claim 12 is limited to the information terminal of claim 10, as covered by Bayless. Bayless discloses a telephony interface (figure 3, element 44; column 10, lines 6-21) (i.e. TAPI), which receives an outgoing telephone number from the application program and actually generates the calling signals, or DTMF signals, to a central office. Therefore, Bayless anticipates all limitations of the claim.

Claim 13 is limited to *the information terminal of claim 11*, as covered by Bayless. As described in the rejection of claim 5, the number that is selected and dialed, which is the number that is entered into the database by the importation wizard (figure 31) (i.e. *extraction means*), is displayed in the *first window* (figure 86, the toolbar with the number 5174) (i.e. *wherein the display application means controls said display to display to display the extracted telephone number in the first window*). Therefore, Bayless anticipates all limitations of the claim.

Claim 15 is limited to *the information terminal of claim 11*, as covered by Bayless. As described in the rejection of claim 6, the *first window* operates with an unobstructed view of the other windows that the OS displays (i.e. *wherein the display application means controls said display to display the first window which is overlapped on the top of the plurality of windows displayed in the display*). Therefore, Bayless anticipates all limitations of the claim.

Claim 16 is limited to *the information terminal of claim 11*, as covered by Bayless. Bayless discloses that when a telephone call is placed, additional dialing string

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information is appended to incorporate dialing plan information (figure 84, phone number is 5105, but the dial string is 95105) (i.e. *wherein the output means adds a given number to the top of the extracted telephone number, and outputs the extracted telephone number with the given number*). Therefore, Bayless anticipates all limitations of the claim.

Claim 17 is limited to *the information terminal of claim 11*, as covered by Bayless. As seen in the call displays of figures 82 and 83, each call that is placed includes a text string, usually the name of the person associated with the called telephone number (i.e. *wherein the display application means attaches a given character string to the extracted telephone number, and controls said display to display the extracted telephone number with the given character string*). Therefore, Bayless anticipates all limitations of the claim.

Claim 18 is limited to *the information terminal of claim 11*, as covered by Bayless. Because Bayless discloses that the operating system is a Windows OS (column 7, lines 44-8), the operating system inherently places the *first window* into an inactive state when it is not the active window (i.e. *wherein the display application means controls the first window to an inactive state responsive to an inactive signal*). Therefore, Bayless anticipates all limitations of the claim.

Claim 19 is limited to *the information terminal of claim 18*, as covered by Bayless. *Extraction* requires invoking the importation of a directory, not the mere deactivation of the first window (i.e. *wherein the extraction means does not extract the telephone*

number from the character information responsive to said inactive signal). Therefore, Bayless anticipates all limitations of the claim.

Claim 20 is limited to *the information terminal according to claim 11*, as covered by Bayless. When the *first window* is opened (i.e. set to a tool bar display form), seen in figures 82 and 83 of Bayless, a telephone number is not being entered into the database (i.e. *extracted*), in order to perform a database entry the importation wizard must be open (see, figure 31) (i.e. *wherein when the display application means sets the first window to a tool bar display form, the extraction means does not extract the telephone number from the character information*). Therefore, Bayless anticipates all limitations of the claim.

Claim 21 is limited to *the information terminal according to claim 11*, as covered by Bayless. As seen in figures 82 and 83 of Bayless, *the first window is a toolbar* (i.e. *wherein said first window is displayed as a tool bar*). Therefore, Bayless anticipates all limitations of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayless in view of Detering et al. (US Patent 5,588,049).**

Claim 4 is limited to *the telephone call dialing method according to claim 1*, as covered by Bayless. As stated above in the rejection of claim 1, Bayless discloses that the database is populated with telephone numbers and an associated name. The database is populated by importing a directory from another telephony application (column 23, lines 56-63). The numbers are imported from a text file, but the internal format of the numbers as stored in the database is not disclosed by Bayless. Therefore, Bayless anticipates all limitations of the claim with the exception of *deleting information except for that relevant to numerals from the selected string of character information, and the telephone number is extracted from the resulting remainder*.

Detering teaches a method of applying call prefixes to numbers (abstract). However, the relevant aspects of Detering involve the dial setup or database entry steps. As seen in figure 5, a telephone number is input by a user in the upper left. The number to be dialed, and as stored is shown in the bottom right. It is clear of formatting, therefore, the number stored is in the exact form of the number to be dialed (column 2, lines 11-31). Clearly, this is necessary because other characters in a dialing string have little or no meaning, such as dashes, and should be removed to avoid program errors. It would have been obvious to one of ordinary skill in the art at the time of the invention to format character strings input from a text file by removing all characters that are numerals, as taught by Detering, for the purpose of removing characters that cannot be dialed and should not be passed to a DTMF generator.

Claim 14 is limited to the information terminal of claim 10, as covered by Bayless. For the same reasons as in claim 4, Bayless fails to disclose extracting a number

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according to the claim steps herein, however, the teachings of Detering make up for this deficiency. Therefore, Bayless in view of Detering makes obvious all limitations of the claim.

Response to Arguments

While new grounds of rejection are hereby presented, the same prior art reference to Bayless is relied upon. In order to expedite the prosecution, and perhaps clarify some issues, responses to arguments that pertain to the current grounds of rejection are included below.

- 4. The applicant's arguments with respect to claim 1, filed in the Appeal Brief (paper 17, dated 10 June 2004), have been considered, but are not persuasive.**

With respect to claim 1, the applicant alleges that the dragging-and-dropping does not correspond to the selecting steps of the claim (page 7); the examiner respectfully disagrees. As shown in the rejection of claim 1 in view of Bayless a more complete process of directory importation is described. The selection provides the import map with a target for extraction. Furthermore, dialing by way of directory lookup uses the numbers entered into the directory. The *storing* is not a responsive step, and the order the steps are written in does not necessarily determine the order the steps occur in.

With further respect to claim 1, the applicant alleges that the telephone number is extracted from the string of characters (page 8); the examiner respectfully disagrees.

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The applicant tries to define a general window of the OS that is different than the windows of Bayless, however, no such limitation is presented in the claims and is a moot argument. Furthermore, the mapping shown in figure 31 clearly includes telephone number fields.

Other arguments related to Bayless are based on grounds of rejection not relied upon herein, and thus, are moot.

Conclusion

This action is non-final because of reopened prosecution and the addition of new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F Briney III whose telephone number is 703-305-0347. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WFB
8/31/04



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